

REMARKS

Claims 1-20 and 22-33 are pending in this application.

By this amendment, Applicant proposes to amend claims 23-25 to correct a clerical error in regard to claim dependency, and not for reasons related to patentability. Applicant further proposes to amend the Abstract.

Objections to Claims 23-25, 10, and 20

The Examiner objected to claims 23-25 because those claims depend from canceled claim 21 instead of amended claim 22. Claims 23-25 are being amended to depend from claim 22. Thus, this objection is believed to be obviated.

The Examiner also objected to claim 10 because the last section of the claimed “first signal processing means...” allegedly “does not make sense” in light of amended claim 1. In addition, the Examiner objected to claim 20 because the last section of the claimed “second signal processing means...” allegedly “does not make sense” in light of amended claim 1. However, the recitations of the “first signal processing means” of claim 10 and the “second signal processing means” of claim 20 appear to “make sense” in relation to the language of claim 1. In addition, claims 1, 10, and 20 are all independent claims and thus are not required to be consistent with each other.

§ 103(a) Rejection of Claims 1-4, 6-12, 14-28, and 30-39 over *Bar-EI*

The Examiner rejected claims 1-4, 6-12, 14-28, and 30-39 under 35 U.S.C. §103(a) as unpatentable over WO 99/26415 (“*Bar-EI*”). Applicant respectfully traverses this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness under §103(a), each of three requirements must be met. “First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art,” to combine references or modify a reference. MPEP § 2143 (8th ed. Rev. Feb. 2003). Second, a reasonable expectation of success must exist that the proposed modification will work for the intended purpose. *Id.* Moreover, both of these requirements must “be found in the prior art, not in applicant’s disclosure.” *Id.* Third, the reference or references, taken alone or in combination, must disclose or suggest every element recited in the claims. *Id.*

Bar-EI fails to teach or suggest each and every element of claim 1. For example, *Bar-EI* does not teach or suggest:

performing a first signal processing on said television
content data according to software stored in a removable
recording medium ... to output first output content data; and

performing a second signal processing using said first output
content data and said television content data based on said
auxiliary data to generate second output content data.

Instead, *Bar-EI* discloses a “video server 11” that transmits requested video sequences along with video parameters and personalized data to a “user computer 12.” An individual “personalization module 62” residing in the “user computer 12” creates personalized videos therefrom. (Page 17, lines 4-13). *Bar-EI* thus fails to teach or

suggest performing a “first signal processing” as recited in claim 1 and performing a “second signal processing” as recited in claim 1.

Moreover, the Examiner acknowledged that “Bar-EI does not explicitly disclose performing a first signal processing on the television content data according to software stored in a removable recording medium” (Office Action, pg. 6). To make up for this deficiency, the Examiner took Official Notice that “it is notoriously well known in the art of television set-top boxes (STBs) and computer systems which have television broadcast reception capabilities to have software stored in a removable recording medium ...” (Office Action, pg. 6).

However, it is not appropriate for the Examiner to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection is based. MPEP § 2144.03(A) (citing *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697). The Examiner should either point to some concrete evidence in the record in support of his finding, or if the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. MPEP § 2144.03(C). Thus, the Examiner should either provide evidentiary support in the record, or the Examiner should withdraw this rejection.

Independent claims 10, 16, 19, 20, 22, and 26 should be allowed over *Bar-EI* for reasons substantially similar to those explained above in relation to claim 1. For example, *Bar-EI* fails to teach or suggest the “first signal processing means” and the “second signal processing means” recited in claim 10, claim 20, or claim 26. *Bar-EI* also

does not teach or suggest the “signal processing means” and the “signal combining means” recited in claim 16. Furthermore, *Bar-El* does not teach or suggest performing the “desired first signal processing” recited in claim 19 to produce first output content data, and “processing said first output content data” as recited in claim 19. *Bar-El* also fails to teach or suggest a “viewer apparatus” that performs the “desired first signal processing” and the “predetermined second signal processing” recited in claim 22.

Thus, because claims 2-3 and 6-9 are dependent from claim 1; claims 11, 12, 14, and 15 are dependent from claim 10; claims 17 and 18 are dependent from claim 16; claim 21 is dependent from claim 20; claims 23-25 are dependent from claim 22; and claims 27, 28, and 30-39 are dependent from claim 26, claims 1-4, 6-12, 14-28, and 30-39 should be allowed over *Bar-El*.

§103(a) Rejection of Claims 5, 13, and 29 over *Bar-El* and *Sitrick*

The Examiner additionally rejected claims 5, 13, and 29 under 35 U.S.C. § 103(a) as being unpatentable over *Bar-El* in view of U.S. Patent No. 6,425,825 to Sitrick (“*Sitrick*”). Applicant respectfully traverses this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

Claims 5, 13, and 29 depend from claims 1, 10, and 26, respectively. *Sitrick* does not appear to make up for the deficiencies of *Bar-El* explained above in relation to claims 1, 10, and 26. The Examiner only relies on *Sitrick* to allegedly disclose “a system and methodology where replacement predefined character images and existing game display functions ... may be utilized in association with predefined game character and game display functions” (Office Action, pg. 22, paragraph 4).

Thus, since *Bar-El* and *Sitrick* do not teach or suggest each and every element of claims 1, 10, and 26, these claims and claims 5, 13, and 29 dependent therefrom are allowable over *Bar-El* and *Sitrick*.

Applicant respectfully requests entry of this Amendment After Final as placing the application in condition for allowance. In the alternative, the proposed Amendment at least places the application in better form for appeal by, for example, removing the objection to claims 23-25.


In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 15, 2005

By: 
Reece Nienstadt
Reg. No. 52,072